

Doctor's Associates Inc ("SUBWAY")
vs
Lim Eng Wah (trading as SUBWAY NICHE)
("SUBWAY NICHE")

PLAINTIFF'S MARK	DEFENDANT'S MARK
	

Lim Eng Wah (trading as SUBWAY NICHE) ("SUBWAY NICHE") began operating a stall in Singapore under the name "SUBWAY NICHE" in 1987 and now runs a chain of stalls selling local food and drinks such as nonya kueh and bubble tea.

Doctor's Associates Inc ("SUBWAY") owns and operates the franchise for the popular international sandwich chain named "SUBWAY". SUBWAY is the registered proprietor for the "SUBWAY" word mark in relation to trademark classes 29, 30, 32, 42, 43, the earliest registration being in 1989, two years after SUBWAY NICHE began operation. The first SUBWAY outlet opened in Singapore nine years after SUBWAY NICHE was opened.

SUBWAY claimed, inter alia, trademark infringement against SUBWAY NICHE in relation to Classes 30 and 30 for the sale of sandwiches, and Class 43 for the operation of the Subway niche restaurant. SUBWAY also claimed the defendant passed off its registered SUBWAY trademarks through the use of the SUBWAY NICHE sign. The High Court considered three main issues, namely, infringement under section 27(2)(b) of the Act, infringement under section 27(3) of the Act and the tort of passing off.

Under the issue of infringement under section 27(2)(b) of the Act, although the High Court finds that the marks are aurally, conceptually and visually similar, and that both marks were used for similar goods, the likelihood of confusion among customers are merely hypothetical or speculative. The High Court was not convinced that there was a likelihood of confusion of the marks as there was no evidence to show that SUBWAY NICHE's goods originated from or were associated SUBWAY's.

For infringement under section 27(3) of the Act, it was established that the SUBWAY mark is well known in Singapore in view of the presence of 92 stores and extensive marketing in Singapore. However, the High Court finds that the use of the SUBWAY NICHE mark is not likely to cause confusion as it does not indicate a connection between the SUBWAY NICHE's goods and SUBWAY's. There was insufficient evidence of damage to SUBWAY's interests and the damages identified were again merely hypothetical.

As for the tort of passing off, the High Court find that at the time the offending conduct commenced, SUBWAY had not acquired the necessary goodwill in the SUBWAY mark in relation to sandwiches in Singapore. Therefore, there is no need for the High Court to consider whether there was any actionable misrepresentation or damage to goodwill.

SUBWAY's claims in relation to trade mark infringement and passing off are dismissed with costs.

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